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EXAMINER

LERNER, AVRAHAM H

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3611

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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 28

Application Number: 09/421,676
Filing Date: October 20, 1999
Appellant(s): GOTZ, BERNHARD

William Logsdon
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 5, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is substantially correct. The terminal disclaimer filed November 5, 2003 has been approved, and therefore the rejection of claim 21 under obviousness-type double patenting is withdrawn. The remainder of the claim status as written by appellant is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: the terminal disclaimer filed November 5, 2003 has been approved, and therefore the rejection of claim 21 under obviousness-type double patenting is withdrawn. Issues a, b, and c as written by appellant are correct.

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(7) *Grouping of Claims*

Appellant's brief includes a statement that the claims as grouped do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Group A, claim 1;

Group B, claim 21;

Group C, claim 22;

Group D, claim 7;

Group E, claims 2-6 and 8-19.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

4,202,453	Wilkes, Jr. et al.	5-1980
6,085,858	Wakana et al.	7-2000

(10) *Grounds of Rejection*

Claims 1-19, 21 and 22 are rejected under 35 U.S.C. 112, second paragraph. This rejection is set forth in prior Office Action, Paper No. 19.

Claims 1, 7, 21, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilkes, Jr. et al. This rejection is set forth in prior Office Action, Paper No. 19.

Claims 2-6 and 8-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkes, Jr. et al. in view of Wakana et al. This rejection is set forth in prior Office Action, Paper No. 19.

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(11) Response to Arguments

Rejection of claims 1-19, 21, and 22 under 35 U.S.C. 112, second paragraph:

Regarding the rejection under 35 U.S.C. 112, appellant argues that the phrase “separate from the frame and connected to the frame” is not unclear, indefinite and/or contradictory because the 1988 edition of the Random House College Dictionary (attached by appellant) includes several definitions of “separate” which do not directly contradict the word “connected”. First, it is noted that the initial definition of “separate” (as an adjective as it appears in the claims) from the same dictionary reads “12. detached, disconnected, or disjointed.” The primary, most relevant definition of “separate” actually uses the word “disconnected”, the literal antonym of “connected”, and therefore reciting that an element is separate from the frame and connected to the frame is unclear and self-contradictory. It is also noted that in appellant’s arguments citing the various secondary definitions, several editing liberties have been taken which further discredit the assertion that there could be no confusion inherent to the above language. Contrary to appellant’s *quoted* citation, definition 13 also includes **unconnected** with distinct and unique, and definition 15 continues to clarify that “existing or maintained independently” refers to, for example, separate *organizations*, not relevant to vehicle structure.

Dictionary semantics aside, the rejection of the claims is predicated on the requirements of 35 U.S.C. 112, second paragraph, which states that the claims must particularly point out and distinctly claim the subject matter which the applicant regards as his invention. Due to the two parts of the above limitation having opposite conventional and art-accepted meanings, it is difficult to ascertain exactly what is meant by “a rear weight separate from the frame and connected to the frame”, and therefore the claims fail to comply with the statute.

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Rejection of claims 1, 7, 21, and 22 under 35 U.S.C. 102(b):

Group A, claim 1:

Regarding the rejection of claim 1 as being anticipated by Wilkes, Jr. et al. (hereafter Wilkes), appellant argues that the limitation “rear weight” as presented in the claims cannot be equated with the “body of power unit 12”. Appellant cites Chelin, wherein (in lines 35-36 of column 2) it is recited “the counterweight 18 may be formed in any desired fashion” and several other U.S. Patents which teach counterweights, quoting specific language as to how these other counterweights are mounted. Appellant further argues that Chelin and the other U.S. Patents named provide evidence that counterweights are commonly used in the art, and therefore “one of ordinary skill in the industrial truck art would clearly understand that the term “rear weight” refers to a component different from, i.e. separate from, the vehicle frame, the engine, or the body of the Wilkes power unit 12.” In response, it is first noted that none of the references specifically chosen by applicant to demonstrate the accepted meaning of “rear weight” use this term anywhere in the patents. Each refers to a counterweight, which is not considered the same as simply reciting a “rear weight” as in the instant claims. Additionally, even if the term “rear weight” is to be considered a counterweight, Wilkes states multiple times (e.g. the last sentence of the abstract) that the power unit (12) is used as a counterbalance to an object being lifted by the crane. Further, while the meanings of claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. See In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969), wherein the court stated, “reading a claim in light of the

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specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim."

In the instant case, the claims merely recite a "rear weight", which by broadest reasonable interpretation means a weight on a rear portion of the vehicle.

The heavy (by design to act as a counterweight) structure surrounding the internal combustion engine 38 in Wilkes is a "rear weight", it is "separate" (as best understood) from the frame (frame of utility unit 14) and connected to the frame, and it is positioned between the engine and the frame as claimed.

On page 9 of the Supplemental Brief, appellant also argues that Wilkes does not teach or suggest the claimed industrial truck for the reason that "the Examiner simply designates the utility unit 14 as a 'frame' and the power unit 12 as the 'rear weight' with the engine 38 mounted on the power unit 12 as being equivalent to the claimed invention.... Appellant believes one of ordinary skill in the industrial truck art would clearly understand that an industrial truck 'frame' refers to the framework of the industrial truck and not simply to an attached, articulated unit." In response, it is first noted that "one of ordinary skill in the art" is not relevant to a rejection under 35 U.S.C. 102, but only in determining obviousness under 35 U.S.C. 103. Second, as recited above in detail, the broadest reasonable claim interpretation lends the metal structure supporting the crane to be considered a "frame", and the large, specifically-by-design heavy element labeled '12' by Wilkes to be considered a "rear weight", and lastly the internal combustion engine 38 to be considered an "internal combustion engine".

Group B, claim 21:

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As stated by appellant, claim 21 “more broadly recites that the internal combustion engine is fastened to the rear weight and carried on the industrial truck by the rear weight.” The arguments reiterate the more detailed points made regarding claim 1, and appellant again states that Wilkes does not disclose a rear weight as claimed. In that appellant’s arguments are the same regarding what is lacking in Wilkes, the examiner’s response is the same, and it is believed Wilkes anticipates each and every claimed limitation, as recited above in detail. Once again, the heavy structure surrounding the internal combustion engine 38 in Wilkes is a “rear weight”, it is separate from the frame (frame of utility unit 14) and connected to the frame (as best understood), and the engine is fastened to the rear weight such that the engine is carried on the truck by the rear weight.

Group C, claim 22:

Claim 22 is similar to claims 1 and 21, however it recites that the internal combustion engine is mounted on the rear weight by fastening means such that vibrations from the engine are transmitted to the rear weight by the fastening means and such that the engine is connected to the frame by the rear weight. Appellant states that the inclusion of “fastening means” renders claim 22 patentable over Wilkes, and with respect to claims 1 and 21, but provides only arguments directed to the assertion that Wilkes does not disclose an industrial truck rear weight nor an equivalent thereto. Therefore, the examiner’s position regarding what is considered a “rear weight”, recited above in detail, is reiterated. It is further noted that engine of Wilkes is inherently connected to the rear weight by “fastening means”, which would necessarily transmit vibrations from one to the other, and therefore this limitation does not serve to define over the prior art.

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Group D, claim 7:

Claim 7 is dependent on claim 1, and further recites a hydraulic unit fastened to the engine such that the hydraulic unit and engine are mounted directly on the rear weight.

Appellant states that although Wilkes discloses that the engine is provided with a gear box transmission driving three hydraulic pumps, this is not equivalent to the claimed invention.

However, it is noted that the "hydraulic unit" of Wilkes is made up of at least pumps 44, 45, 46, and tank 118 (see Fig. 7). In column 5, lines 19-21, Wilkes states "In the power unit 12, stiffening walls 114 are used to form a fuel tank 116 and a hydraulic oil tank or reservoir 118."

As recited above, the power unit 12 is considered a "rear weight" as broadly recited, and therefore Wilkes anticipates all claimed limitations.

Rejection of claims 2-6 and 8-19 under 35 U.S.C. 103(a):

Group E, claims 2-6 and 8-19:

The claims stand rejected as being unpatentable over Wilkes in view of Wakana et al. (U.S. Patent No. 6,085,858). Applicant's arguments are fully directed to the notion that Wakana et al., either alone or in combination with Wilkes, does not teach or suggest an industrial truck as claimed in claim 1 having a rear weight separate from the frame and an internal combustion engine mounted on the rear weight, as well as the remainder of limitations set forth in claim 1. Applicant continues to state that since claims 2-6 and 8-19 depend from claim 1, they must be allowable over the cited art.

In response it is noted that the combination of Wilkes and Wakana et al. is not challenged, and therefore will not be considered by the Board of Patent Appeals and

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Interferences. See 37 CFR §1.192(a) ("Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown."). The issue is *solely* whether or not the two references, when taken in combination, either show or make obvious all elements as claimed. Further, because the claims of this group are stated by applicant to stand or fall together, for the sake of succinctness, the merits of only claim 2 will be addressed in detail herein. Claim 2 adds that the internal combustion engine is oriented in a substantially transverse direction of the industrial truck. Although the rejection made final in the last Office action (paper #19), sets forth each element critical to fulfilling the Graham Factual Inquiries (see MPEP 2141), the only matter made issue by appellant is whether or not all elements are present in the combination. Regarding claim 2, Wilkes discloses all elements except for the orientation of engine being transverse to that of the truck. Wakana et al. teaches that an internal combustion engine may be oriented in a substantially transverse direction of a vehicle in order to improve vibration properties of the engine. Therefore, all elements are indeed taught by the combination, and the rejection has been sustained by the examiner. Appellant argues that other limitations specific to dependent claims 3, 6, 13, and 14 are not taught by Wakana et al. and/or Wilkes, but since these claims stand or fall with claim 2, these arguments have not been addressed.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

AVRAHAM LERNER
PRIMARY EXAMINER

A. Lerner 12/9/03

Avraham Lerner
December 9, 2003

Conferees

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